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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,456	07/25/2003	Fertac Bilge	P1396 US	3417
28390	7590	03/31/2005	EXAMINER	
MEDTRONIC VASCULAR, INC.			PRONE, CHRISTOPHER D	
IP LEGAL DEPARTMENT			ART UNIT	
3576 UNOCAL PLACE			PAPER NUMBER	
SANTA ROSA, CA 95403			3738	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,456

Applicant(s)

BILGE, FERTAC

Examiner

Christopher D Prone

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a catheter tip retention device, classified in class 606, subclass 140.
- II. Claims 14-16, drawn to a method of manufacturing a catheter, classified in class 420, subclass 446.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process wherein the ring will be stretched and positioned in the groove of the tip before pushing the catheter tip on the end of the catheter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Janis Biksha on 03/01/05 a provisional election was made without traverse to prosecute the invention of the catheter tip retention device, claims 1-13. Affirmation of this election must be made by applicant in

replying to this Office action. Claims 14-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Regarding claims 11-13, the word "means" is preceded by the word(s) "wall" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Claims 11-13 also fail to specify any function with several other means clauses.

Claims 12-13 recite the limitation "the shape memory means" in the first line of each claim. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 5,554,181 Das.

In reference to claims 1 and 11, Das discloses the same invention being a catheter tip retention device comprising: a catheter tip referenced as elements 80 and

81 and a retaining ring constructed of a shape memory material referenced as element 101 shown in figures 1-17 of Das and described in column 3 on lines 61-65.

In reference to claim 2, Das discloses the same invention wherein the ring comprises an alloy of nickel and titanium described in column 3 on lines 61-65.

In reference to claim 3, Das discloses the same invention wherein it is inherent that the retaining ring is in an austenitic phase in the first configuration.

In reference to claim 4, Das discloses the same invention wherein it is inherent that the retaining ring is in a temperature induced martensitic phase in the second configuration.

In reference to claim 5, Das discloses the same invention wherein it is inherent that the retaining ring is in a stress induced martensitic phase in the second configuration.

In reference to claim 6, Das discloses the same invention wherein it is inherent that the shape memory alloy has a phase transformation temperature of below about 68 degrees Fahrenheit.

In reference to claim 7, Das discloses the same invention wherein the catheter has an end shown in figures 1-17 of Das.

In reference to claim 8, Das discloses the same invention wherein the end of the catheter comprises an inner member of a catheter referenced as element 84 of Das.

In reference to claim 9, Das discloses the same invention wherein the ring causes an interference fit between the catheter tip and the end of the catheter shown in figures 1-17 of Das.

In reference to claim 10, Das discloses the same invention wherein the catheters tip comprises a slot referenced as element 82 of Das, in the outer circumference of the catheter tip configured to receive the ring.

In reference to claim 12, Das discloses the same invention wherein it is inherent that the shape memory means is temperature set to the first configuration.

In reference to claim 13, Das discloses the same invention wherein it is inherent that the shape memory means comprises a spring means for causing the retaining means to return to the first set configuration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday Through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-6085. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CDP


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